

REMARKS

I. Formalities

Applicant thanks the Examiner for indicating that the Formal Drawings filed on August 1, 2001 have been accepted.

II. Status of the Application

Claims 1-16 are all the claims pending in the application, with claims 1 and 15-16 being in independent form. Claims 1-16 have been rejected.

The present Response addresses each point of objection and rejection raised by the Examiner. Favorable reconsideration is respectfully requested.

III. Claim Rejections - 35 U.S.C. § 102

The Examiner has rejected claims 1-2, 9 and 12-16 under 35 U.S.C. § 102(e) as being anticipated U.S. Patent No. 6,029,065 to Shah (hereinafter "Shah"). Applicant respectfully traverses this rejection for *at least* the independent reasons stated below.

According to the MPEP, "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP § 2131. Applicant respectfully submits that claims 1-2, 9 and 12-16 positively recite limitations which are not disclosed (or suggested) by Shah.

A. Independent Claim 1

Independent claim 1 recites (among other things):

...connecting a communication terminal of a
first network to a private base...

Shah discloses a method of programming network feature codes in mobile stations. (col. 1, lines 5-7). The grounds of rejection allege that the disclosure in Shah that Mobile Station 100 transmits signals to the Base Station 200, corresponds to the feature of connecting a communication terminal of a first network to a private base, as recited in claim 1. (*See* 02/18/05 Office Action, page 2). Applicant respectfully disagrees with the grounds of rejection.

Shah fails to disclose or suggest connecting a communication terminal of a first network to a private base, as recited in claim 1. In fact, Shah discloses quite the opposite—that the Mobile Station 100 transmits signals to a base station of a public mobile telephone network. (col. 2, lines 9-21; Figures 2-4; Abstract).

Claim 1 explicitly requires the feature of connecting a communication terminal of a first network to a private base. More particularly, the term “base” as recited in claim 1 is modified by the adjective “private.” In stark contrast, Shah discloses that the Base Station 200 is a base station of a public mobile telephone network and is therefore accessible by visiting mobile stations (e.g., Mobile Station 100). (*See e.g.*, col. 2, lines 9-21; Figures 2-4; Abstract). Indeed, the fundamental objective of Shah is to provide a method for remote feature code programming for a “visiting mobile station” (i.e., a visiting mobile station which is accessing a public base station, rather than the mobile station’s home network). (col. 3, lines 25-53). Therefore, Shah does not teach, and is incapable of suggesting, that the Base Station 200 disclosed therein corresponds to a “private base,” as recited in claim 1.

As made clear in the present specification, a private base, is completely different than a base station of a public mobile telephone network, as disclosed in Shah. (*See e.g.*, page 5, lines

1-3). Indeed, the specification describes that a private base and a base station of a public mobile telephone network are completely different devices, with completely different structures and different functions. For instance, the present specification describes that the range of a private base is generally restricted compared to the range of a base station of a public mobile telephone network. Further, the specification describes an exemplary embodiment of the present invention wherein the range of a private base 102 is restricted to a few hundred meters and, as a result, is not picked up by the base stations of a public mobile telephone network. (Page 5, lines 1-3).

Hence, Shah fails to disclose or suggest the feature of connecting a communication terminal of a first network to a private base, as recited in claim 1. Thus, Applicant respectfully submits that independent claim 1 is not anticipated by (i.e. is not readable on) the applied Shah reference for *at least* these independent reasons. Further, Applicant respectfully submits that the dependent claims 2-14 are allowable *at least* by virtue of their dependency on claim 1.

Thus, Applicant respectfully requests that the Examiner withdraw this rejection.

B. Independent Claim 15

Independent claim 15 recites (among other things):

... a private base connected to a second network, wherein said communication terminal is connected to said private base...

In view of the similarity between these requirements and the requirements discussed above with respect to independent claim 1, Applicant respectfully submits that the foregoing arguments as to the patentability of independent claim 1 apply *at least* by analogy to claim 15. As such, it is respectfully submitted that claim 15 is patentably distinguishable over the cited

Shah reference *at least* for reasons analogous to those presented above. Thus, the allowance of this claim is respectfully solicited of the Examiner.

C. Independent Claim 16

Independent claim 16 recites (among other things):

... a private base connected to a second network, wherein said communication terminal is connected to said private base...

In view of the similarity between these requirements and the requirements discussed above with respect to independent claim 1, Applicant respectfully submits that the foregoing arguments as to the patentability of independent claim 1 apply *at least* by analogy to claim 16. As such, it is respectfully submitted that claim 16 is patentably distinguishable over the cited Shah reference *at least* for reasons analogous to those presented above. Thus, the allowance of this claim is respectfully solicited of the Examiner.

IV. Claim Rejections under 35 U.S.C. § 103 – Shah in view of Sipilä

The Examiner has rejected claim 3 under 35 U.S.C. § 103(a) as being unpatentable over Shah, in view of European Patent Application No. EP 0 748 136 A1 to Sipilä (hereinafter “Sipilä”). Applicant respectfully traverses this rejection for *at least* the independent reasons stated below.

In order for the Examiner to maintain a rejection under 35 U.S.C. § 103, Shah, Sipilä, or some combination thereof, must teach or suggest all of the limitations of claims claim 3. Applicant respectfully submits that neither Shah, Sipilä, nor any combination thereof, teaches or suggests all of the limitations of claim 3.

Claim 3 incorporates all the novel and non-obvious limitations of its base claim 1. As set forth above, Shah fails to disclose or suggest the feature of connecting a communication terminal of a first network to a private base, as recited in claim 1. Further, Sipilä also fails to teach or suggest this feature. Therefore, Applicant respectfully submits that claim 3 is patentable over Shah, Sipilä, and any combination thereof, for *at least* these independent reasons. Thus, Applicant respectfully requests that the Examiner withdraw this rejection.

V. Claim Rejections under 35 U.S.C. § 103 – Shah in view of Sipilä and further in view of Kasmperschroer

The Examiner has rejected claims 4 and 6-7 under 35 U.S.C. § 103(a) as being unpatentable over Shah, in view of Sipilä, and further in view of U.S. Patent No. 6,434,399 to Kasmperschroer (hereinafter “Kasmperschroer”). Applicant respectfully traverses these rejections for *at least* the independent reasons stated below.

Claims 4 and 6-7 incorporate all the novel and non-obvious limitations of their base claim 1. As set forth above, Shah fails to disclose or suggest the feature of connecting a communication terminal of a first network to a private base, as recited in claim 1. Further, both Sipilä and Kasmperschroer also fail to teach or suggest this feature. Therefore, Applicant respectfully submits that claims 4 and 6-7 are patentable over Shah, Sipilä, Kasmperschroer, and any combination thereof, for *at least* these independent reasons. Thus, Applicant respectfully requests that the Examiner withdraw these rejections.

VI. Claim Rejections under 35 U.S.C. § 103 – Shah in view of Sipilä further in view of Kasmperschroer and further in view of Heuvel

The Examiner has rejected claim 5 under 35 U.S.C. § 103(a) as being unpatentable over Shah, in view of Sipilä, further in view of Kasmperschroer, and further in view of U.S. Patent No. 5,924,014 to Heuvel, *et al.* (hereinafter “Heuvel”). Applicant respectfully traverses this rejection for *at least* the independent reasons stated below.

Claim 5 incorporates all the novel and non-obvious limitations of its base claim 1. As set forth above, Shah fails to disclose or suggest the feature of connecting a communication terminal of a first network to a private base, as recited in claim 1. Further, Sipilä, Kasmperschroer, and Heuvel also fail to teach or suggest this feature. Therefore, Applicant respectfully submits that claim 5 is patentable over Shah, Sipilä, Kasmperschroer, Heuvel, and any combination thereof, for *at least* these independent reasons. Thus, Applicant respectfully requests that the Examiner withdraw this rejection.

VII. Claim Rejections under 35 U.S.C. § 103 – Shah in view of Kasmperschroer

The Examiner has rejected claims 8-11 under 35 U.S.C. § 103(a) as being unpatentable over Shah in view of Kasmperschroer. Applicant respectfully traverses these rejections for *at least* the independent reasons stated below.

Claims 8-11 incorporate all the novel and non-obvious limitations of their base claim 1. As set forth above, Shah fails to disclose or suggest the feature of connecting a communication terminal of a first network to a private base, as recited in claim 1. Further, Kasmperschroer also fails to teach or suggest this feature. Therefore, Applicant respectfully submits that 8-11 are patentable over Shah, Kasmperschroer, and any combination thereof, for *at least* these

independent reasons. Thus, Applicant respectfully requests that the Examiner withdraw these rejections.

VIII. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

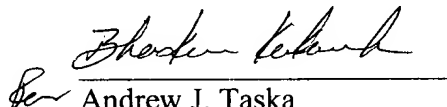
Respectfully submitted,

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

 *Ref No: 54,627*

Andrew J. Taska
Registration No. 54,666

Date: May 18, 2005